



Our Reference: MOR-221-A

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Wakayama, et al.
Serial Number: 09/601,390
Filing Date: July 31, 2000
Examiner/Art Group Unit: Hopkins, R./1724
Title: FILTER MEDIUM FOR AIR FILTER AND
PROCESS FOR PRODUCING THE SAME

COPY OF PAPERS
ORIGINALLY FILED

PETITION FROM REQUIREMENT FOR
RESTRICTION PURSUANT TO 37 C.F.R § 1.144

Assistant Commissioner of Patents
Washington, D.C. 20231

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Sir:

The subject application is a national stage application. In the Office Action dated September 25, 2001, a Restriction Requirement was imposed between the following inventions under 35 U.S.C. § 121 and § 372.

Group I claim(s) 1 - 8, and 17, drawn to a filter medium and method for manufacturing a filter medium.

Group II, claim(s) 12 - 13, drawn to a method for manufacturing semiconductors.

Group III, claim(s) 9 - 11 and 14 - 16, drawn to a clean room.

A response to the Restriction Requirement was filed with a Certificate of Mailing on October 25, 2002. The response elected Group I, claim 1 - 8 and 17 with traverse. The Restriction Requirement was made final in the Office Action dated February 21, 2002.

The present Petition From Restriction requests review of the Restriction Requirement by the Commissioner pursuant to 37 C.F.R. § 1.144.

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First, with respect to the grouping of Group I claims, Group II claims and Group III claims, pursuant to PCT Rule 13.4:

Subject to Rule 13(1), it shall be permitted to include in the same international application a reasonable number of dependent claims, claiming specific forms of the invention claimed in an independent claim, even where the features of any dependent claim could be considered as constituting in themselves an invention.

Claims 9 - 11, and 14 - 16 (Group III) are dependent claims, ultimately dependent upon independent claim 1. Claims 12 - 13 (Group II) are dependent claims ultimately dependent upon claim 1.

Second, with respect to the grouping between Group I claims, Group II claims, and Group III claims, pursuant to PCT Rule 13.2, the following requirements must be established.

...Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, make over the prior art.

The Examiner states that the inventions listed in Groups I - III do not relate to a single general inventive concept under PCT Rule 13.1 and that they lack corresponding special technical features. The Examiner alleges that Group I is directed to a filter medium having a special technical feature of a binder not shared by any of the remaining groups. The Examiner further alleges that Group II is directed to a method of manufacturing semiconductors having a special technical feature of a silicon wafer not shared by any of the remaining groups. The Examiner also alleges that Group III is directed to a clean room having the special technical feature of a clean bench, clean booth, wafer stocker, wafer transfer space, and semiconductor fabrication equipment not shared by any of the remaining groups.

However, unity does exist between claims 1 - 18. The special technical feature common to all of the claims is the air filter comprising a filter medium. The

claims 1 - 18 are analogous to the example 13 as illustrated on page AI-60 in ANNEX B, UNITY OF INVENTION, PART 1, INSTRUCTIONS CONCERNING UNITY OF INVENTION in the MANUAL OF PATENT EXAMINING PROCEDURE (M.P.E.P.)

For the aforementioned reasons, the restriction requirements imposed in the Office Action dated September 25, 2001 are improper. The Commissioner is requested to instruct the patent Examiner to withdraw the Office Action dated February 21, 2002 and to issue a new Office Action withdrawing the restriction requirement and/or examining claims 9 - 16 on the merits. The Commissioner's review of this restriction requirement is requested. A check for the petition fee of \$130.00 is enclosed with this Petition.

Respectfully submitted,

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Dated: April 10, 2002
DPC/dge